

REMARKS

This Amendment is responsive to the Office Action dated June 27, 2006, the response to which is due September 27, 2006. Attached hereto is a request for a two month extension of time and the appropriate fee. In the application, Claims 18 - 20 are allowed and claims 8 and 9 are objected to, but indicated to include allowable subject matter. Applicant would initially like to thank the examiner for the indication of allowable subject matter. As to the remaining claims, Applicant has amended Claim 1 to better frame the invention. It is respectfully submitted that Claim 1 as amended is now in condition for allowance, which likewise places the remaining claims in a similar condition. Applicant therefore respectfully requests reconsideration of the claims as amended in view of the remarks presented below.

The Present Invention

The configuration of the present invention is unlike that of any game played today, and has unique benefits that are unrealized outside of the present invention. The location of the goals beyond the ends of the rink effectively adds twenty to thirty feet of playing area from which a player can score, and is a much safer configuration that prevents injuries which may result when players crash into the goal. The area behind the net is eliminated, and this also adds a degree of safety as many injuries occur in the area behind the net where congestion of players occur in a compact space. The result is a more free flowing and exciting game to watch and play.

The chamfered corners of the rink are also unique in that they create a more predictable response to shots than rounded corners of traditional rinks. The predictability allows for greater strategy, advanced plays, and a higher level of competition.

The bumper of Claim 10 is also unique in that it serves the purpose of accelerating the puck off the boards instead of decelerating the puck, which dramatically changes the action much like an air hockey game where the puck comes off the boards in a true but fast motion. This also plays into the strategy of the game and presents many options and plays that are not available in traditional hockey rinks.

The Prior Art

Martin, U.S. Patent No. 6,126,551

Martin discloses a rink and corridor recreational facility where multiple rinks are connected by one or more corridors. Martin is not cited in the Office Action as disclosing anything other than that square rinks were known in the art.

Sullivan, U.S. Patent No. 6,354,969

Sullivan discloses an instructional method and system for team sports, but the Office Action cites only to the soccer field to show that it was known in the art to place goals on the endline of a playing field. However, the hockey rink shown in Figure 5 of the Sullivan patent shows the goals in the traditional location, which defeats any suggestion that Sullivan suggests a hockey rink with goals like a soccer field. Rather, Sullivan shows just the opposite - a hockey rink with goals spaced from the endline.

The Proposed Combination of Martin and Sullivan

The Office Action stated that it would have been obvious to modify the playing surface of Martin with the goals of Sullivan "for the advantage of allowing the playing surface of Martin to adapt to different types of team sports." [Office Action, p. 4]. Applicant respectfully submits that unless there is a suggestion in the references to play soccer on the Martin rink, there is no earthly reason why one would modify the Martin rink to include goals aligned on the endline. Sullivan even shows that rinks (Figure 5) have different goal configurations from soccer, and there the fact that both soccer and ice rinks existed in the past does not mean there was an obvious suggestion or motivation in the art to combine the two. The mere recitation that "it would have been obvious" without something in the prior art to suggest the motivation invites the improper use of hindsight to use the Applicant's disclosure against the Applicant. It is respectfully submitted that there is no basis for concluding that it would have been obvious to configure a hockey rink for playing soccer as suggested by the Office Action, and that the rejection of Claim 1 for obviousness is improper.

Rejection Under 35 U.S.C. §103

To establish a *prima facie* case of obviousness, the Office Action must achieve three objectives: (1) The Office Action must demonstrate suggestion or motivation, either in the references themselves or in the prior art, to modify the reference as suggested by the Office Action or to combine the references as suggested by the Office Action; (2) The Office Action must establish that the proposed combination has a reasonable expectation of success; and (3) The Office Action must demonstrate that each claim limitation in each claim is taught or suggested in the cited references. M.P.E.P. §706.02(j). Accordingly, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000). "The absence of such a suggestion to combine is *dispositive*

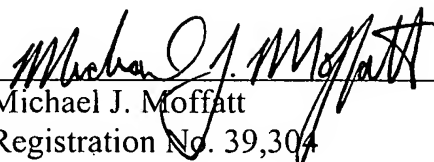
in an obviousness determination." *Gambro Lundia AB v. Vaxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

In the present case, the Office Action has managed to find isolated components of the Applicant's invention but has failed to demonstrate that the motivation to combine is present in the prior art. It must be kept in mind that "the factual inquiry whether to combine references must be thorough and searching." *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (emphasis added). In the present application, there is no evidence of motivation to combine but rather a simple conclusory statement that it is so. If this were all that were required to establish an obviousness rejection, very few if any patents would ever issue.

Applicant has developed a new and exciting game played on a novel playing field unlike any other, although certainly features of the novel field can be found in other playing areas. This is not fatal to the Applicant's invention, however, as virtually all inventions are made up of known parts. Here, Applicant respectfully submits that the claims as amended patentably distinguish over the cited art and early notification of allowability is earnestly solicited. If the Applicant believes that a telephone interview will further the prosecution of this case, the examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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